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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/053,387

01/17/2002

Jian Ling Ding

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33717

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04/15/2009

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

GHALL, ISIS A D

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

04/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/053,387	DING ET AL.	
	Examiner	Art Unit	
	Isis A. Ghali	1611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Isis A Ghali/
Primary Examiner, Art Unit 1611

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 32, 35-39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of 4,738,257 ('257) and US 4,335,026 ('026).

Applicants argue that the combination of EPDM and PIB yields a compound that possesses unexpected properties and is therefore not taught or suggested by Meyer or Balin. Applicant argue that table 2 showed higher saline absorption than the prior art hydrocolloid and table 3 showed in example 16 that without PIB and having only hydrophobic polymer EPDM, the percentage saline absorption of a composition drastically decreased. Applicant further argue that none of the cited references suggested combination of EPDM with PIB to achieve high absorption capacity.

In response to this argument, it is argued that the present claims are directed to composition, and all the elements of the composition are disclosed by combination of the references. Meyer teaches diene compound, irrespective of its intended use or function. Meyer used the diene compound in wound dressing. Balin reference desired to include diene compounds in its composition for treating wounds and preferred EPDM having 75% ethylene and 25% propylene because it provides wound dressing having the advantage of decreased resistance to peel removal while maintaining high shear resistance in air and in water. One having ordinary skill in the art would have been replaced one diene compound by another or further add EPDM to the composition already comprising DCPD as permitted by the claims' language. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In considering the disclosure of the reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826, 159 USPQ 342,344 (CCPA 1968). The rational to modify or to combine the prior art does not have to be expressly stated in the prior art; the rational may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve different problem. It is not necessary that the prior art suggest the combination or modification to achieve the same advantage or result discovered by applicant. In *re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). The invention as a whole is taught by the combination of Meyer and Balin.

It has been held that: "When a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (2007) (quoting *Sakraid v. AG Pro, Inc.*, 425 U.S. 273,282 (1976)). "When the question is whether a patent claiming the combination of elements of prior art is obvious," the relevant question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." In addition, "To determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit. But it need not seek out precise teachings directed to the challenged claim's specific subject matter, for a court can consider the inferences and creative steps a person of ordinary skill in the art would employ". Pp. 11-14. *KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL.* (2007).

Regarding tables 2 and 3, it is noted that tables 1-3 of the present specification, that compare the properties of the present compositions with the prior art compositions regarding integrity of the composition and absorbency do not show unexpected results. The tables showed that the prior art US 4,551,490 provides integrity of 9 and absorption up to 245, while the present compositions provides similar, less or equivalent integrity and absorbency. For example, examples 2 and 11 showed integrity of 9 that is the same as US 4,551,490. Examples 1, 8, 10, and 11 showed integrity of 8 that is less than US 4,551,490 and example 12 showed more reduced integrity of 6. Therefore, no unexpected results were presented regarding integrity due to combination of PIB and EPDM. The saline absorbency of the present examples showed low absorbency that are lower than the prior art, example 16 showed 71, and the prior art showed higher absorbency. Additionally, the present composition is taught by the combined teachings of the prior art and all its elements are disclosed by the combination, therefore, the properties of the composition obtained from combination of the prior art are expected to be the same as instantly claimed since materials and their properties are inseparable. The unexpected results presented in the specification do not commensurate in scope with the present claims. Tables 1-3 showed many variation in the amount of the ingredients of each composition, and also showed variation in the ingredients of the compositions. No single composition showed unexpected integrity and absorbency that is distinguished over the prior art, and no showing of which ingredient provides such improvement over the prior art. Examples 8-11 showed high absorbency, however, this property is a result of the presence of the hydrophilic particles, and not due to the combination of PIB and EPDM. In addition, regarding the arguments of unexpected superior results in the instant specification, it is the examiner's position that the data in the specification regarding low integrity and high fluid absorbency are not unexpected results and therefore can not rebut *prima facie* obviousness. The examiner directs applicant's attention to MPEP 716.02 (a). "A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness of the claims at issue." In *re Corkhill*, 711 F.2d 1496, 266 USPQ 1006 (Fed.Cir. 1985). In *Corkhill*, the claimed combination showed an additive result when a diminished result would have been expected. Furthermore, the MPEP states, "Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof." In *re Gershon*, 372 F.2d 535, 538, 152 USPQ 602,604 (CCPA 1967).